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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,509	11/19/2003	Masaki Wake	034058-001	4698
21839	7590	03/02/2006	EXAMINER	
BUCHANAN INGERSOLL PC (INCLUDING BURNS, DOANE, SWECKER & MATHIS) POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			RODRIGUEZ, RUTH C	
			ART UNIT	PAPER NUMBER
			3677	

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/715,509	WAKE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ruth C. Rodriguez	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2005.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 and 13 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4-7 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Soltysik (US 3,910,156).

A spacer (10) made of metal and interposed between opposed faces of two members (13 and planar member shown in Figs. 2 and 3) having respective bores co-axial with each other and fastened to each other by inserting a fastening member (14) into the bores and tightening the fastening member (Figs. 2 and 3). The spacer comprises a base (17) and a temporarily retaining portion (11). The base is interposed between opposed faces of the members and has a through hole (16) co-axial with the bores of the respective members so that the fastening member is inserted through the hole (Figs. 2 and 3). The retaining portion is provided on an open edge of the hole of the base to temporarily retain the overall spacer on one of the members before the

members are fastened to each other (Figs. 1-6). The temporarily retaining portion is inserted into the bore of the one member and caught on a wall defining the bore (Fig. 3). The temporary the retaining portion has a pair of projections (11) formed on respective opposite sides of a distal end thereof (Figs. 1-6). The projections extend in a circumferential direction of the hole of the base (Figs. 1-6). Each projection includes a lower edge (tip of 11) formed to be upwardly inclined when the temporarily retaining portion is inserted into the bore of said one member (Figs. 1-6). Each projection is brought into sliding contact with the one edge of the bore of said one member so that the overall spacer is moved toward a central axis of the bore of said one member (Figs. 1-6).

The temporarily retaining portion is located at an outer peripheral side of the fastening member so as to be non-contact with fastening member (Fig. 3).

The temporarily retaining portion is flexibly bent at the open edge of the hole of the base so as to extend substantially axially and is in contact with the wall of the bore with a spring force pressing the temporarily retaining portion against the wall (Figs. 3-6).

A plurality of temporarily retaining portions is provided on the open edge of the hole of the base at regular intervals (Figs. 1-6).

The temporarily retaining portion includes a root portion and two slits formed in both widthwise ends of the root portion so as to extend from the open edge of the hole axially outward, respectively (Fig. 6).

The temporarily retaining portion has a falling-off preventing claw (tip) formed thereon by cutting a part thereof and raising the cut part, so as to be engaged with the wall of the bore of the one member (Figs. 3-6).

Both projections can be stamped out of a base metal while lower edges of the projections are inclined from the lower edge of the temporarily retaining portion (Figs. 1-6).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Soltysik.

Soltysik discloses a spacer having all the features mentioned above for the rejection of claim 1. Soltysik fails to disclose that the spacer has a surface to which an insulating coating is applied. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply an insulating coating to a surface of the spacer disclosed by Soltysik since the Examiner takes Official Notice that insulating coating is used in application where electrical insulation is needed such as when a metal outlet box is being installed to a wall or any component having a metal

planar member that could come into contact with electricity and it is desired to use the spacer.

***Allowable Subject Matter***

5. Claims 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claims 12 and 13 are allowed.

***Response to Arguments***

7. Applicant's arguments filed 1 December 2005 have been fully considered but they are not persuasive.

The Applicant argues that the temporary retaining portion disclosed by Soltysik is not provided in the open edge of the hole of the base because the wall portions 27 and 28 are not provide on the open edge of the hole of the base. This argument fails to persuade because the claim recites "each projection being brought into sliding contact with the open edge of the bore of said one member so that the overall spaces is moved towards a central axis of the bore of said one member". The claim does not require provide the retaining portions on the open edge of the base as argued by the Applicant. Therefore, in response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the retaining portion is provided on the open edge of the hole of the base) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. Regarding claim 3, the Examiner has modified the claim to indicate that the planar member shown in Figures 2 and 3 can be part of a metal outlet box being installed to a surface with the spacer or any part of metal element having a planar member that could be in contact with electricity and that will require the electrical insulation.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Greenburg (US 1,400,155), Tinnerman (US 2,244,975), Johnson (US Re. 22,618 and Re. 22,544), Goldberg (US 3,226,145), McKewan (US 4,430,033), Bredal (US 4,749,318), Fisher (US 4,925,351), Ijima et al. (US 5,172,999), Bondarowicz et al. (US 6,582,171) and Hsich (US 6,811,347) are cited to show state of the art with respect to washers or spacers that have some of the features claimed by the current application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for



Art Unit: 3677

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

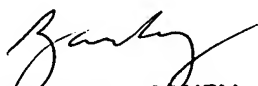
For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Ruth C. Rodriguez  
Patent Examiner  
Art Unit 3677

rcr  
February 21, 2006

  
**ROBERT J. SANDY**  
**PRIMARY EXAMINER**